PATENT
Attorney Docket No.: 05725.0008/2800
Application No.: 09/820,934
Customer No.: 22,852

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

David W. CANNELL et al.

Application No.: 09/820,934 — Group Art Unit: 1615

Filed: March 30, 2001 — Examiner: L. Channavajjala

For: HEAT ACTIVATED DURABLE CONDITIONING COMPOSITIONS COMPRISING C_1 TO C_{22} SUBSTITUTED C_3-C_5 MONOSACCHARIDES AND METHODS FOR USING THE SAME

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENTS

A. Restriction Requirement

In the Office Action mailed April 24, 2002, the Examiner has required restriction between the following groups of claims:

Group I: Claims 1-59, drawn to a composition, classified in class 424, subclass 70.1; and

Group II: Claims 60-186, drawn to a method for caring or treating keratinous fibers, classified in class 424, subclass 70.1.

The restriction requirement, as set forth above and on pages 2-3 of the Office Action, is respectfully traversed. However, to be fully responsive to the restriction

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requirement, Applicants elect, with traverse, the subject matter of Group I, claims 1-59.

Applicants refer the Examiner to M.P.E.P. § 803, which sets forth the criteria and guidelines for Examiners to follow in making proper requirements for restriction. The M.P.E.P. instructs Examiners as follows:

> If the search and examination of an entire application can be made without **serious burden**, the Office **must** examine it on the merits, even though it includes claims to distinct or independent inventions.

M.P.E.P. § 803 (emphasis added).

Here, the Examiner has not shown that examining the above groups together would constitute a serious burden. In fact, according to the present Office Action, Groups I and II are all classified in the identical class and subclass - class 424, subclass 70.1. Accordingly, a search for these groups of claims will substantially, if not completely, overlap. Thus, for at least this reason, Applicants respectfully submit that the restriction requirement is in error and request that the requirement be withdrawn.

B. Election of Species Requirement

The Examiner has also required an election of a single disclosed species from each of the following two subgroups (A) and (B):

(A) a compound comprising at least two quaternary ammonium groups derived from one of the following:

1. polymers comprising at least two quaternary ammonium groups derived from at least one vinyl monomer;
2. cationic diallyl quaternary ammonium polymers comprising at least two quaternary ammonium groups;
3. derivatives of polysaccharide polymers comprising at least two quaternary ammonium groups; and
4. silicone polymers comprising at least two quaternary ammonium

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groups; and

(B) a C_3 to C_5 monosaccharide substituted with at least one C_1 to C_{22} carbon chain chosen from:

1. pentoses and derivatives of pentoses;
2. tetraoses and derivatives of tetroses;
3. trioses and derivatives of trioses; and
4. furanoses and derivatives of furanoses.

Applicants traverse these election of species requirements on the grounds that the Examiner has not shown that there would be a serious burden to examine all of the alleged species. In fact, the Examiner has failed to show that any burden exists. *See* pages 3-4 of the present Office Action.

However, to be fully responsive to the election of species requirement, Applicants elect, with traverse, (A)(3) derivatives of polysaccharide polymers comprising at least two quaternary ammonium groups. Derivatives of polysaccharide polymers comprising at least two quaternary ammonium groups are disclosed, for example, at page 13, lines 8-20, in the Example at pages 22-23, and read on claims 1-9 and 13-59 of Group I. Further, Applicants elect, with traverse, polyquaternium-10 as the species of at least one compound comprising at least two quaternary ammonium groups chosen from derivatives of polysaccharide polymers comprising at least two quaternary ammonium groups. This species is disclosed, for example, at page 13, line 13, page 14, line 13, in the Example at pages 22-23, and read on claims 1-9 and 13-59.

Applicants elect, with traverse, (B)(1) pentoses and derivatives of pentoses. Pentoses and derivatives of pentoses are disclosed, for example, at page 15, line 13-21, in the Example at pages 22-23, and read on claims 1-9 and 13-59 of Group I.

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Further, Applicants elect, with traverse, XYLIANCE as the species of at least one sugar chosen from C_3 to C_5 monosaccharide substituted with at least one C_1 to C_{22} carbon chain chosen from pentoses and derivatives of pentoses. XYLIANCE brand modified pentoses is a blend of hexadecyl glycosides and octadecyl glycosides wherein the glycosides comprise D-xylosides, L-arabinosides, and D-glucosides. XYLIANCE is disclosed, for example, at the Example at pages 22-23.

As discussed above, Applicants traverse the election of species requirement on the grounds that the Examiner has not shown that there would be a serious burden to examine all of the claimed species. Accordingly, Applicants respectfully request that the full scope of the claimed invention be examined in this application. If the Examiner chooses to maintain the election requirement, however, and the elected species is found to be allowable, Applicants expect the Examiner to continue to examine the full scope of the claimed subject matter to the extent necessary to determine the patentability thereof, *i.e.*, extending the search to the non-elected species, as is the duty of the Examiner according to M.P.E.P. § 803.02 and 35 U.S.C. § 121.

If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, she is invited to call the undersigned at (202) 408-4173.

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Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: May 24, 2002

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